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OFFICE OF PETITIONS

Paper No. 17

In re Application of
Michael REED et al.
Application No. 08/113,955
Deposited: August 31, 1993
Attorney Docket No. E4800.001P00

ON PETITION

This is in response to the petitions filed November 1, 2007 under 37 CFR 1.53(b) again requesting that the above-identified application be accorded a filing date of August 31, 1993, under 37 CFR 1.182 requesting the specification be amended to include a benefit claim for priority to U.S. Patent 5,241,671, and under 37 CFR 1.183 requesting waiver of the requirements of 37 CFR 1.53 and 1.181(f).

The petitions are **DISMISSED**.

The above-identified application was deposited with the USPTO on August 31, 1993. On September 14, 1993, a letter was mailed by Application Division requiring page 1 of the specification and stating that the filing date would be the date of receipt of the omitted page and further required an oath of declaration in compliance with 37 CFR 1.63, \$710 for the basic filing fee, \$1,446 for additional claims and the \$130 surcharge, if necessary. In response to the September 14, 1993 letter, a petition and an unsigned preliminary amendment was filed October 29, 2003. The petition did not include any of the fees required in the Office letter of September 14, 1993. On February 16, 1994, a decision dismissing the petition was mailed and indicated: (1) MPEP 608.01 sets forth that an application is considered incomplete, if it omits one or more pages of the specification; (2) since the application, as deposited, omitted page 1 of the specification, the application is *prima facie* incomplete; (3) that while the petition argued that the omitted page was unnecessary for an understanding of the claimed subject matter, the petition was not accompanied by an oath or declaration by the inventors as required by MPEP 608.01; (4) if the inventors agree that page 1 is unnecessary for an understanding of their invention, the application may be accorded a filing date of August 31, 1993, upon the filing of a request for reconsideration, accompanied by an oath or declaration in compliance with 37 CFR 1.63 by the inventors including a statement that their invention is adequately disclosed in, and they wish to rely on, the application as amended on October 29, 1993, without page 1 of the specification for

purposes of an original disclosure and filing date; and (5) requiring a request for reconsideration to be filed within two (2) months of the date of the decision in order to be considered timely. As applicant failed to submit the required omissions a Notice of Abandonment under 37 CFR 1.53 was mailed March 23, 1995.

Petitioner requests: (1) waiver of the requirements of 37 CFR 1.181(f); (2) that this application is given a filing date of August 31, 1993; (3) the extension of time fee tendered February 28, 2004 be reallocated; and (3) the application be amended to delete page 1 and insert a benefit claim.

Petitioner argues: (1) the copendency requirements of 35 U.S.C. 120 have been met; (2) petitioner was not alerted to the lack of a priority claim in the above-identified application; (3) examination of the child application proceeded even though the instant application did not have a benefit claim; (4) the child application indicated that benefits under 35 U.S.C. 120 were being claimed to the parent application via the instant application; and (5) USPTO practice has since changed with respect to incomplete applications.

As the instant application was deposited with the USPTO on August 31, 1993 one must look to the statutes, rules, and procedures in effect at the time of the deposit of the application, *i.e.*, MPEP Fifth Edition Rev. 15. Petitioner cannot rely upon later promulgated statutes, rules, and procedures to support his assertions that a filing date of August 31, 1993 be granted to the instant application.

At the time of filing of the instant application –

35 U.S.C. 111 stated:

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawings are submitted, within such period and under such conditions, including payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

35 U.S.C 120 stated:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or

inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

37 CFR 1.22(b) stated:

All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.

37 CFR 1.53(b) stated:

The filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to §1.71 and at least one claim pursuant to §1.75; and (2) any drawing required by §1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by §1.41. No new matter may be introduced into an application after its filing date (§1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in §1.17(i)(1) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and §1.78(a)) may be filed pursuant to the section, §1.60 or 1.62. A continuation-in-part may be filed pursuant to this section or §1.62.

37 CFR 1.53(d) stated:

If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by applicant, the applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in §1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in §1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of.

37 CFR 1.78(a) stated:

An application may claim an invention disclosed in a prior filed copending national application or international application designating the United States of America. In order for an application to claim the benefit of a prior copending national application, the

prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the prior application must be (1) complete as set forth in §1.51, or (2) entitled to a filing date as set forth in §1.53(b) and include the basic filing fee set forth in §1.16; or (3) entitled to a filing date as set forth in §1.53(b) and have paid therein the processing and retention fee set forth in §1.21(l) within the time period set forth in §1.53(d). Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application, identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the application. Cross-references to other related applications may be made when appropriate. (See §1.14(b).)

MPEP 201.07 stated:

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned or patented. The continuing application may be filed under 37 CFR 1.53, 37 CFR 1.60 or 37 CFR 1.62. The applicant in the continuing application must include at least one inventor named in the prior application. The disclosure presented in the continuation must be the same as that of the original application, i.e. the continuation should not include anything which would constitute new matter if inserted in the original application.

At any time before the patenting or abandonment or termination of proceeding on his or her earlier application, an applicant may recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner.

MPEP 201.11 stated:

Under certain circumstances an application for patent is entitled to the benefit of the filing date of a prior application which has at least one common inventor. The conditions are specified in 35 U.S.C. 120.

There are four conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120:

1. The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or original application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

2. The continuing application must be copending with the first application or with an application similarly entitled to the benefit of the filing date of the first application.
3. The continuing application must contain a specific reference to the prior application(s) in the specification.
4. The continuing application must be filed by an inventor or inventors named in the previously filed application.

COPENDENCY

Copendency is defined in the clause which requires that the second application must be filed before (a) the patenting, or (b) the abandonment of, or (c) the termination of proceedings in the first application.

And further stated:

When proceedings in an application are terminated, the application is treated in the same manner as an abandoned application, and the term "abandoned application" may be used broadly to include such applications.

MPEP 202.02 stated:

The inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

MPEP 608.01 stated:

Applications filed without all pages of the specification are not given a filing date since they are "prima facie" incomplete. The filing date is the date on which the omitted pages are filed. If the oath or declaration for the application was filed prior to the submission of all pages of specification, the submission of any omitted pages must be accompanied by a supplemental oath or declaration referring to the specification originally deposited, as amended to include the pages originally omitted. If the oath or declaration for the application was not filed prior to the submission of the omitted pages, the oath or declaration when filed, must include a specific reference to pages originally omitted. If any applicant believes that the omitted pages of the application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the

oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support.

37 CFR 1.181(f) states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Initially it is noted that 37 CFR 1.181(f) permits the dismissal of a petition not filed within two months of the mailing date of the action or notice from which relief is requested. The instant petitions appear to complain about the petition decision mailed February 16, 1994. As over 13 years 8 months passed between that action and the instant petitions, the instant petitions are dismissed as untimely. As noted in Korsinsky v. Godici, 2005 U.S. Dist. LEXIS 20850, (S.D.N.Y. 2005), by operation of regulation, the Commissioner was entitled to dismiss Korsinsky's petition as untimely.

Petitioner makes many statements as to what the staff at Dickstein Shapiro desired to do or believed was occurring between August 31, 1993 and February 24, 1994. However, petitioner has provided no statements from parties having first hand knowledge of what occurred during this time period.

With respect to the petition under 37 CFR 1.53(b), the requirements of the Office letter mailed September 14, 1993, the petition decision mailed February 16, 1994, and MPEP 608.01 (Fifth Edition Rev. 15) have yet to be met and, in any event, were not timely met. Accordingly, no filing date can be granted.

Petitioner further argues that the copendency requirements of 35 U.S.C. 120 have been met and therefore an amendment to the first sentence of the specification setting forth the benefit claim should be entered. The instant application was deposited with the USPTO on August 31, 1993; however, as the instant application was never accorded a filing date and does not contain a specific reference to the prior application(s) in the specification, the requirements of 35 U.S.C. 120 and 37 CFR 1.78(a) have not been met. Therefore, the requested amendment to the specification will not be made.

Next, petitioner requests reallocation of the fees paid in the instant application. Despite petitioner's statement that the fees should be reallocated in view of a blanket fee authorization, no blanket fee authorization was given. The only authorization given was one to charge extension of time fees. Specifically, the petition for extension of time filed February 28, 1994 stated "In the event that a further petition for an extension of time is required to be submitted at

this time, applicant(s) hereby petition(s) under 37 CFR 1.136(a) for an extension of time for as many months as are required to ensure that the above-referenced application does not become abandoned." Moreover, at the time of filing of the instant application 37 CFR 1.22(b) required fees to be itemized in each individual application in such a manner that it is clear for which purpose the fees are paid. In the instant application there was no request to pay any fees other than an extension of time fee. Therefore, no reallocation of fees will be undertaken. Furthermore, as proceedings have been terminated in the instant application, no filing, retention, additional claim, or surcharges will be accepted at this time.

Petitioner further requests waiver of the Rules under 37 CFR 1.183. The issue at hand is not whether petitioner was alerted to the fact that the instant application did not claim benefit to the parent application nor is it what actions petitioner may have taken in another application; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence herein. As such the granting of a filing date petition in a child application and the examination of such child application are irrelevant to the actions taken in the instant application. As set forth in MPEP 202.02 (Fifth Edition Rev. 15) the inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier date. In the instant application, a review of the record indicates that this application was not filed in accordance with 35 U.S.C 111 and 37 CFR 1.53(b) and accordingly was not granted a filing date. Moreover, petitioner was on notice that the application was not accorded a filing date and was apparently aware of that fact as evidenced by their filing of a petition on October 29, 1993 requesting a filing date be granted. As such, petitioner knew or should have known that a benefit claim to the instant application was improper under 35 U.S.C. 120 and 37 CFR 1.78(a).

Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977). Accordingly, failure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules under 1.183.

The requirements of 35 U.S.C. 111 and 35 U.S.C 120 have not been met. Petitioner is reminded that no Executive branch agency may act in derogation of a federal statute. See A.F. Stoddard & Co. v. Dann, 564 F.2d 556 (D.C. Cir. 1977).

As the instant petitions are being treated as a petition under 37 CFR 1.182 and 37 CFR 1.183, the petition fees of \$400 set forth in 37 CFR 1.17(f) are required. Accordingly, the petition fees of \$800 will be charged to petitioners Deposit Account No. 50-2929.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney documents must be

submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7099.



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